

REMARKS

Claims 1, 3–16, and 18-29 are pending. Claim 2 and 17 were previously canceled. New claims 19-28 have been added. Applicants gratefully acknowledge the Examiner's statement that claims 5 and 6 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants respectfully request reconsideration and allowance of all pending claims of this application.

Applicants begin by noting that the current rejections of the claims under 35 U.S.C. §112, ¶ 2, and under 35 U.S.C. §102 based on U.S. Patent No. 5,037,517 to Naik, are improper because the examiner totally misconstrues the legal effect of the transition phrase “comprising” used in these claims. The Federal Circuit has made clear that “‘comprising’ is not a weasel word with which to abrogate claim limitations.” *Spectrum International Inc. v. Sterillite, Corp.*, 161 F.3d 1372, 49 U.S.P.Q.2d 1065 (Fed. Cir. 1998) Yet that is exactly what the examiner is doing when he asserts that “metal” as used in these claims can be construed to include a metal oxide because of the open-ended nature of “comprising.”

A metal is an element with a zero valence state. When that metal reacts with oxygen to form an oxide, that element is no longer a metal. Instead, it is a cation. Therefore, it is clearly erroneous in fact and in law to say that the aluminum oxide of the Naik reference corresponds to the “metal” in applicants' claims merely because “comprising” is used in the transition phrase of these claims. This is exactly what the patent owner tried to do in the *Spectrum* case, and this is exactly what the Federal Circuit soundly rejected when it said “‘comprising’ is not a weasel word with which to abrogate claim limitations.”

Similarly, the Court of Customs and Patent Appeals, the predecessor of the Federal Circuit, has made crystal clear that a patent claim is not objectionable for formal reasons under 35 U.S.C. §112, merely because it uses “comprising” in its transition phrase. See, Ex parte Vollheim, 191 U.S.P.Q. 407 (C.C.P.A. 1976). Therefore, it is clearly erroneous in fact and in law to say that applicants claims are indefinite merely because “comprising” is used in the transition phrase of these claims.

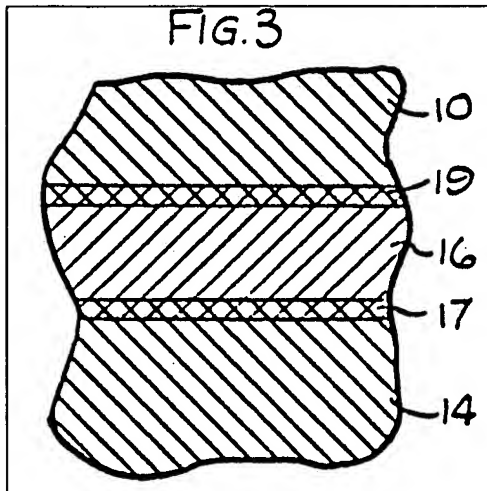
There is nothing indefinite in reciting that a particular claim ingredient “comprises... a metal.” Nor does a metal oxide “comprise...a metal.” Accordingly, these rejections are erroneous and should be withdrawn without further delay.

Claims 1, 3–4, and 7–18 stand rejected under 35 U.S.C. § 102(b) as assertedly being anticipated by U.S. Pat. No. 5,037,517 to Randhawa. Applicants respectfully traverse this rejection and request reconsideration and withdrawal of the rejection.

The Office Action asserts that the exterior gold layer (1) of Randhawa ‘517 “will wear away and expose the transparent layer (16) which will in turn allow for the color layer (14) to show through.” The Office Action further asserts that “the transparent layer (16) of Randhawa will be the exterior layer after wearing of the initial gold outer layer and also during the manufacture of the article.” Transparent layer (16) is “pure refractory metal, such as Ti, Zr, or Hf.” Col. 3, lines 42–43.

In stark contrast, claim 1 of the present application, as amended, claims “[a]n article having on at least a portion of its surface, a thin transition layer consisting of a metal bearing material and having a composition that varies from an exterior first composition comprising purely metal to a second composition beneath the exterior first composition, which transition layer is superimposed on a metal bearing color layer . . .” Transparent layer (16) of Randhawa ‘517 is not a transition layer having an exterior first composition and a second composition beneath the exterior first composition. Transparent layer (16) of Randhawa ‘517 is “pure refractory metal, such as Ti, Zr, or Hf.” Col. 3, lines 42–43. So, Randhawa ‘517 does not disclose the claimed invention.

The Office Action also asserts that Randhawa ‘517 discloses an article with two graded/transitioned layers. There is “a graded interface or transition zone 17 located between hard coating layer 14 and transparent layer 16 and another graded interface or transition zone 19 located between transparent layer 16 and top gold layer 20 [sic—10].” Col. 4, lines 15–19. Figure 3 from Randhawa ‘517 illustrating these transition zones is shown below.



Randhawa '517 Fig. 3

Transition zone 19 is located between outer gold layer 10 and the transparent layer 16. Transition zone 17 is between transparent layer 16 and gold-colored hard coating layer 14. The transition layer claimed in claim 1 of the present invention is a single transition layer with “an exterior first composition” and is “superimposed on a metal bearing color layer.” Neither transition zone 17 nor transition zone 19 of Randhawa '517 has an exterior first composition and is superimposed on a metal bearing color layer, as claimed in the present application. Transition zone 17 is adjacent to gold-colored hard coating layer 14, and does not have an exterior first composition. Transition zone 19 is not both superimposed on a metal bearing color layer and having an exterior first composition.

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick*, 221 USPQ 481, 485 (Fed. Cir. 1984) (emphasis added). Randhawa '517 does not have a transition layer as claimed in the present application. The '517 patent does not disclose the transition layer claimed in the present application and Applicants respectfully request withdrawal of the rejection based on Randhawa '517.

As discussed above, the references cited in the Office Action do not disclose at least one of the elements present in the claims of the present application.

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Finally, new formal drawings are submitted along with this Amendment, as requested by the examiner.

Conclusion:

In view of the above remarks and amendment, it is submitted that claims 1, 3-16, and 18-28 are in condition for allowance. Prompt notice of such allowance is respectfully requested.

Respectfully submitted,



Date

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